

## REMARKS

Claims 1-70 are pending in this application, with claims 1-44 and 54-62 having been withdrawn from consideration in a prior election. Claims 43-53 and 63-70 stand currently rejected as described below.

Submitted concurrently with this Response are: (1) a Request for Continued Examination (along with the requisite fee); (2) a Petition for Extension of Time under 37 C.F.R. § 1.136(a) extending the time for responding to the Office Action to June 11, 2009 (along with the requisite fee); (3) an Information Disclosure Statement disclosing a newly located patent reference, a co-pending design patent application, and a decision by the Board of Patent Appeals and Interferences with respect to that co-pending application; and (4) a Declaration under 37 C.F.R. § 1.132 of Brandon Fixsen (with associated Exhibits).

### *Interview*

Applicant first notes with appreciation that on May 6, 2009, Applicant's attorney met with Examiner Chang at the Patent Office and provided a demonstration of a product embodying the claimed invention and discussed the application and current rejections. That personal interview is summarized in the Interview Summary mailed by Examiner Chang on May 6, 2009.

### *Rejections*

In the Office Action, the Patent Office has rejected claims 45-47, 68, and 70 as being obvious over U.S. Patent No. 5,390,819 to Kaye (hereinafter "Kaye"), rejected claims 48-53 as being obvious over Kaye in view of U.S. Patent No. 2,415,012 to James (hereinafter "James") and rejected claims 63-68 as being obvious over Kaye. The Patent Office refers to office actions of April 13, 2006, January 3, 2007, and September 19, 2007 as providing an explanation of the basis for the rejections.

Applicant respectfully submits that all of the currently-rejected claims are non-obvious and allowable for at least the reasons discussed below.

**A. The Product that Embodies the Claimed Invention has Enjoyed Commercial Success and has Been Praised by Others, Which Demonstrates the Non-Obviousness of the Claimed Invention**

In *KSR International Co. v. Teleflex, Inc.*, the Supreme Court reaffirmed its holding in *Graham v. John Deere Co. of Kansas City*, stating that an obviousness analysis may include an evaluation of any evidence of secondary considerations of non-obviousness. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007) (discussing *Graham v. John Deere Co of Kansas City*, 383 U.S. 1, 17-18 (1966)). "Secondary considerations [such] as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented" and may have relevancy as indicia of non-obviousness. *Graham*, 383 U.S. at 17-18. "The commercial response to an invention is significant to determinations of obviousness, and is entitled to fair weight." *Graham*, 383 U.S. at 35-36. "The rationale for giving weight to the so-called 'secondary considerations' is that they provide objective evidence of how the patented device is viewed in the marketplace, by those directly interested in the product." *Id.* Other courts have considered additional secondary factors in determining non-obviousness, such as praise of a commercial product *Gore v. Garlock*, 202 USPQ 303 (Fed. Cir. 1983).

Applicant refers to the enclosed Declaration of Brandon Fixsen Under 37 C.F.R. §1.132 dated June 2, 2009 ("Fixsen Declaration"), submitted herewith. Brandon Fixsen is the Vice President of Operations of TradeNet Publishing ("TradeNet") a licensed manufacturer and distributor of the Slinky® notepad, a multi-functional stack of repositionable sheets configured for use as a recreational toy embodying the invention claimed in the present application. The

Fixsen Declaration demonstrates the commercial success of the promotional Slinky® notepad as compared to any other promotional product provided by TradeNet over the past twelve years and the praise of the notepad by customers and the advertising./promotional industry.

Specifically, since approximately 1987, TradeNet has offered and provided promotional products to third parties, the promotional items used in the promotion and/or advertising of those third parties' businesses. (Fixsen Declaration ¶ 2).

In 2008, TradeNet entered an agreement with Larry Wittmeyer Jr. (the inventor and owner of the subject patent application) to manufacture, market, and sell a Slinky® notepad embodying the invention claimed in the present application. (Fixsen Declaration ¶ 3). As claimed in the present application, the configuration of the Slinky® notepad allows the stack of flexible sheets to be spread apart in a an accordion-like manner so that the stack of sheets may be used as a recreational toy and (for example) bounced from hand to hand, or placed on an upper surface and permitted to expand downwardly to a lower surface, all in a manner resembling the well-known Slinky® spring toy.

Since its introduction in January, 2009, customer response to the Slinky® notepad has been extremely positive (Fixsen Declaration ¶ 4), and the commercial success enjoyed by the Slinky® notepad has been significant. In less than six months from its introduction , TradeNet has received over \$200,000 in orders for more than a quarter of a million custom imprinted notepads. (Id.) Orders have been received from more than 250 customers, including orders from large, recognizable companies such as Commerce Bank, T-Mobile, Moneygram, Florida Orange Juice, Pepsi Cola, and Clarks Department Stores. (Id.). Based on the initial sales figures and continued customer demand, TradeNet projects that the Slinky® notepad will become one if its best-selling promotional items ever, with first year sales projected to reach \$1,000,000.

It should be noted that the commercial success of the Slinky® notepad is not attributable to marketing, promotion or advertising activities. Specifically, no extraordinary marketing, promotion or advertising activities directed toward the Slinky® notepad were undertaken during first half of 2009 (i.e., the time period of the sales figures cited above). Rather, the significant sales revenues are attributable to the invention of a notepad configured to function as a recreational toy.

In addition to the commercial success of the Slinky® notepad embodying the claimed invention, the unique product has also received praise from others. TradeNet has received more positive customer feedback for the Slinky® notepad than for any other product TradeNet has ever offered. (Fixsen Declaration ¶ 5).

Furthermore, praise of the Slinky® notepad has come from the entire advertising/promotional community. The Slinky® notepad has received a first place *Counselor* Product Design Award for best desk accessory from the Advertising Specialty Institute (ASI). (Fixsen Declaration ¶ 5). Copies of ASI's 2009 Awards Issue featuring the Slinky® notepad are attached to the Fixsen Declarations as Exhibits A and B.

The commercial success of the Slinky® notepad embodying the claimed invention, and the praise by others of the product evidence the non-obviousness of the claimed invention. For at least this reason, the Patent Office's current rejection of the claims should be withdrawn.

**B. Kaye and James do not Disclose or Suggest a Method of Using a Stack of Repositionable Sheets as a Recreational Toy, as Required by the Claimed Invention**

In maintaining the rejection of claims 45-47 and 63-70 as being obvious over Kaye, and claims 48-53 as being obvious over Kaye in view of James, the Patent Office simply refers back to the rejection of those claims made in the Office Action of April 13, 2006, and repeated in the

Office Actions of January 3, 2007 and September 19, 2007. This adherence to the reasoning presented in the original (and subsequent) Office Actions is unfounded, as the cited references provide no teaching, suggestion, or motivation to use a notepad as a recreational toy, and, in fact, *teach away* from any such use. The Patent Office's combination of those references to arrive at the claimed invention can only be accomplished by impermissible hindsight – having the benefit of knowledge of Applicant's invention.

*Teaching, Suggestion, Motivation*

While the Supreme Court in *KSR* rejected a rigid application of the teaching, suggestion, or motivation ("TSM") test in an obviousness inquiry, the Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. *KSR*, 127 S. Ct. at 1731. Moreover, the Court indicated that there is "no necessary inconsistency between the idea underlying the TSM test and the Graham analysis." *Id.* As long as the test is not applied as a "rigid and mandatory" formula, that test can provide "helpful insight" to an obviousness inquiry. *Id.* Further, the Court emphasized that "the combination of familiar elements according to *known* methods is likely to be obvious when it does no more than yield "*predictable results.*"

In this case, Applicant submits that there is absolutely no teaching, motivation, or suggestion in Kaye, James, or their hypothetical combination, to provide a stack of sheets having adhesive disposed on alternately opposite edges and use that stack of sheets as a recreational toy. The Kaye patent is directed to a stack and dispenser of repositionable adhesive sheets. As described in Kaye, "in their preferred use the sheets of the stack 10 are not separated apart as shown in FIG. 4. Instead the stack 10 is contained within a dispenser 22". (column 3, lines 37-40

of Kaye). As further described throughout Kaye, dispenser 22 contains the sheets and allows those sheets to be removed one at time from the dispenser. There is nothing in Kaye that teaches or suggests any manipulation of the sheets outside of the dispenser, much less any suggestion of using the stack of sheets as a recreational toy.

In the current Office Action, the Patent Office refers back to page 3, lines 10-15 of the January 3, 2007 Office Action as explaining the basis for the contention that there was some suggestion of using notepads as a recreational toy (see paragraph 6 of current Office Action).

However, reference back to page 3, lines 10-15 of the January 3, 2007 simply provides a further reference: “applicant is directed to the last Office Action, paragraph 6, wherein it has been explained in detail as to why it would have been obvious to use the stack as are creation toy because said stack, when expanded into the for as shown in figures 4 and 6, as it will provide for recreation to the user.”

Reference back to paragraph 6 of that “last Office Action” (i.e., the Office Action of April 13, 2006) simply provides the following: “However, Kaye fails to teach that the stack is used a [sic] recreational toy.” (Note – Applicant agrees with this assessment, Kaye certainly does fail to teach any such use). Continuing with paragraph 6 of that Office Action “ It would be obvious to one having ordinary skill in the art to modify Kaye by providing the stack of sheet [sic] as a recreational toy because, as shown in figures 4 and 6, the stack is spread into an accordion-like toy, which would provide for entertainment and recreation to the user.” Figures 4 and 6 of Kaye do not, in fact, depict any “accordion-like toy”. Figures 4 and 6 depict expanded views of the stacks of sheets of the invention of Kaye (FIG. 4) and a prior art stack of sheets (FIG. 6). One skilled in the art, viewing the figures of the Kaye patent would have no reason to consider those views to be “accordion-like toys”, there would be no basis to view those figures

as anything other than expanded views as are commonly used in patents. There is certainly no teaching, suggestion, or motivation in those figures (or elsewhere in Kaye, for that matter) to use the depicted stacks of sheets as a recreational toy.

As the Supreme Court articulated in *KSR*, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR*, 127 S. Ct. at 1741. Furthermore, the examiner must identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does (*Id.*, at 1742), and the examiner must make explicit this rationale of the apparent reason to combine the known elements in the fashion claimed, including a detailed explanation of the effects of demands known to the design community or present in the marketplace and the background knowledge possessed by a person having ordinary skill in the art.

In this case, after admitting that Kaye “fails to teach that the stack is used a [sic] recreational toy”, the Patent Office then simply makes the conclusory statement that figures 4 and 6 of Kaye depict “accordion-like toys” thus one skilled in the art would use the stacks as recreational toys. However, the Patent Office provides no reasoning of the rationale behind that conclusion, and provides no explanation as to the marketplace or background knowledge of that person having ordinary skill in the art. In fact, Kaye specifically states that the preferred use of the stack 10 is not separated as shown in Fig. 4, but is contained within a dispenser (Column 3, lines 37-30 of Kaye). Thus, the Patent Office has failed to meet its burden of establishing a *prima facie* case of obviousness and the current rejections should be withdrawn.

*Teaching Away*

There is nothing in either the Kaye or the James patents – either alone or in combination –that suggest using a stack of flexible sheets as a recreational toy. The James patent is limited to a helical coiled spring toy, and has nothing to do with repositionable adhesive sheets commonly used in the office setting. Applicant respectfully submits that when motivated to provide a toy for amusement to the user, one skilled in the art would not be motivated to look to office products, such as repositionable adhesive notes developed and configured for use in a dispenser as disclosed in the Kaye patent.

The James patent also *teaches away* from the claimed invention. First, the James patent is limited to a helical coiled spring toy having a hollow interior. James emphasizes the specific helical coil configuration and the forces and configuration that work to provide the spring action of the toy (e.g. the small radial cross section or width 17 of the spring described at column 1, lines 33-47 and column 2, lines 26-32). There is absolutely nothing in the James patent to suggest that the recreational toy could comprise sheets having first and second major surfaces as claimed. Second, the James patent states that the best results are obtained using spring steel (S.A.E.1040 to S.A.E. 1095). Thus, nothing in the James '012 Patent teaches or suggests a recreational toy comprised of a stack of flexible sheet material as claimed (e.g., paper, vellum, or plastic film).

For at least the reasons stated above, the Patent Office has failed to establish a *prima facie* case of obviousness of the pending claims of the application. The commercial success and praise of the Slinky® notepad embodying the claimed invention provide ample evidence of the non-obviousness of the invention. Furthermore, the cited references provide no teaching, suggestion, or motivation to use a notepad as a recreational toy, and, in fact, *teach away* from




any such use so that the current rejection of the claims in view of the cited references can only be accomplished in hindsight.

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In view of the above, it is respectfully submitted that all pending claims of the present application are not obvious in view of the cited references and are in condition for allowance and eventual issuance. Such action is respectfully requested. Should the Examiner have any further questions or comments which need be addressed in order to obtain allowance, please contact the undersigned attorney at the number listed below.

Acknowledgement of receipt is respectfully requested.

Respectfully submitted,

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